

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty ARC-2490-28.  
Dkt.

CANHAM et al.

Serial No. 09/647,599

Filed: October 3, 2000

Title: IMPLANTS FOR ADMINISTERING SUBSTANCES AND METHODS OF  
PRODUCING IMPLANTS

C/A.U.

C# M#

1615

Examiner: Azpuru

Date: December 22, 2008

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE/AMENDMENT/LETTER**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment 0 minus highest number  
previously paid for 20 (at least 20) = 0 x \$52.00 \$0.00 (1202)/\$0.00 (2202) \$

Independent claims after amendment 0 minus highest number  
previously paid for 3 (at least 3) = 0 x \$220.00 \$0.00 (1201)/\$0.00 (2201) \$

If proper multiple dependent claims now added for first time, (ignore improper); add  
\$390.00 (1203)/\$195.00 (2203) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s)  
One Month Extension \$130.00 (1251)/\$65.00 (2251)  
Two Month Extensions \$490.00 (1252)/\$245.00 (2252)  
Three Month Extensions \$1110.00 (1253)/\$555.00 (2253)  
Four Month Extensions \$1730.00 (1254)/\$865.00 (2254)  
Five Month Extensions \$2350.00 (1255)/\$1175.00 (2255) \$

Terminal disclaimer enclosed, add \$140.00 (1814)/ \$70.00 (2814) \$

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee \$180.00 (1806) \$ 0.00

Assignment Recording Fee \$40.00 (8021) \$ 0.00

Other: \$ 0.00

**TOTAL FEE \$ 0.00**☐ **CREDIT CARD PAYMENT FORM ATTACHED.**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

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NIXON & VANDERHYE P.C.  
By Atty: Arthur R. Crawford, Reg. No. 25,327

Signature: 



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

CANHAM et al.

Atty. Ref.: 2490-28; Confirmation No. 1219

Appl. No. 09/647,599

TC/A.U. 1615

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For: IMPLANTS FOR ADMINISTERING SUBSTANCES AND METHODS OF PRODUCING  
IMPLANTS

\* \* \* \* \*

December 22, 2008

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Alexandria, VA 22313-1450

Sir:

**RESPONSE**

This is responsive to the Official Action of September 22, 2008. Claims 180-189 are pending in the application of which claims 180-185 are rejected while remaining claims 186-189 are allowable but dependent from a rejected claim.

In the Official Action in commenting on applicants' claim for benefit of priority, which was acknowledged, was criticized in that "applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 USC §119(e) as follows: The original specification and claims do not support the new limitation of 'mesoporous'". This is incorrect.

The PCT application (of which the subject application is a national stage entry) has an international filing date of April 16, 1999 and was published on October 28, 1999. Mesoporous silicon is exactly described in the specification at page 5, lines 4-6 "mesoporous silicon (pore size 2 – 50 nm)". Mesopores are specifically mentioned on page 19, line 14.

Applicants pointed out basis for this term when it was first introduced into the claims; see the Amendment of August 15, 2003, page 4, "Mesoporous silicon is described in the specification at page 5, lines 4-6 from which the silicon implant is prepared." explaining the basis for the claims then being added.

Applicants also claim benefit of priority of their GB application filed April 17, 1998. However for purposes of this response a date of April 16, 1999, the international filing date of the underlying PCT application, will be sufficient. Applicants reserve their right to pursue benefit of priority to the GB application, if necessary.

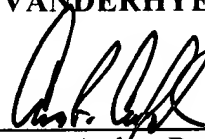
Claims 180-185 stand rejected as being anticipated by Canham 1<sup>st</sup> Annual International IEEE-EMBS Special Topic Conference on Microtechnologies in Medicine and Biology, October 12-14, 2000, Lyon, France. This document is not available as prior art against the claims of the subject application as the published PCT application filed April 16, 1999 antedates the Canham article.

Having perfected benefit of priority and established the date prior to the applied reference claims 180-185 are allowable together with allowable claims 186-189. Reconsideration and allowance are solicited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



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